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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,177	10/31/2003	Rex Wesley Shores	31849.42	9899

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EXAMINER
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CUMBERLEDGE, JERRY L

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/698,177

Applicant(s)

SHORES ET AL.

Examiner

Jerry Cumberledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 22-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/15/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the citizenship of each inventor.

### ***Claim Objections***

Claims 1-21 are objected to because of the following informalities: In claim 1, line 3, it is unclear what "shaft" the Applicant is referring to, since there are multiple elements referred to as shafts in the Applicant's disclosure. It appears that the shaft being referred to in claim 1 is ref. 50, and as such ref. 50 will be considered to be the "shaft" for examination purposes. Appropriate correction/clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaughn et al. (US Pat. 5,569,256).

Vaughn et al. disclose a surgical instrument for the dissection of bone or other tissue having a motor with a power output, the surgical instrument comprising: a tool having a shaft (Fig. 2, ref. 25) with a dissection area (Fig. 2, ref. 31) disposed adjacent a distal end and a coupling area (Fig. 2, ref. 33) disposed adjacent a proximal end; a coupling assembly (Fig. 7, internal mechanism of near ref. 159) configured for coupling the power output to said coupling area of said tool; and an angled attachment tube (Fig. 3, ref. 47) positioned along at least a portion of said shaft and substantially supporting a portion of said shaft disposed adjacent said dissection area, wherein said attachment tube is movably coupled to said coupling assembly (column 3, lines 38-40). The coupling assembly has a longitudinal axis (Fig. 7) and said angled attachment tube is configured for coupling with the coupling assembly at a plurality of locations (column 3, lines 38-40). The attachment tube is configured such that movement along said longitudinal axis is accomplished without substantial rotary motion (Fig. 2, since it can be moved in a longitudinal direction without turning). The attachment tube is axially movably coupled to said coupling assembly (Fig. 3). The instrument further includes a second coupling assembly linked to said coupling assembly, said second coupling assembly adapted to selectively lock said attachment tube to said coupling assembly (column 5, lines 63-67 and column 6, lines 1-25). The second coupling assembly includes a locked position wherein said attachment tube is locked to said coupling assembly, a guiding position wherein said attachment tube is moveably coupled to said coupling assembly, and an open position wherein said attachment tube is removed from said coupling assembly (column 5, lines 63-67 and column 6, lines 1-25). The coupling

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assembly and said attachment tube include a projection and detent retention system therebetween to retain said attachment tube in said guiding position (column 5, lines 63-67 and column 6, lines 1-25). The attachment tube defines a plurality of elongated detents along an outer surface and said coupling assembly includes at least one projection for mating with said elongated detents (column 5, lines 63-67 and column 6, lines 1-25). The at least one projection may be slidably disposed in said elongated detents to permit axial movement of said attachment tube with respect to said coupling assembly (column 5, lines 63-67 and column 6, lines 1-25). The coupling assembly includes an aperture for receiving said attachment tube and at least one movable projection extending into said aperture, wherein said movable projection cooperates with said attachment tube to retain said attachment tube in the guiding position (column 5, lines 12-47). The movable projection provides a tactile sensation to the user to indicate movement between the open position and the guiding position, since the motion of the components will necessarily cause a vibration through the device. The motor includes a motor housing and said coupling assembly is removably coupled to the motor housing (column 2, lines 65-67 and column 3, lines 1-5). The angled attachment tube includes a curved portion (Fig. 3, ref. 47, angled portion near ref. 53). The shaft includes a reduced diameter portion (Fig. 2, near ref. 35). The shaft includes a curved portion (Fig. 3, near ref. 33).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaughn et al. (US Pat. 5,569,256).

With regard to claim 16, Vaughn et al. discloses bearings associated with the attachment tube (column 5, lines 63-67 and column 6, lines 1-25). Vaughn et al. does not disclose at least one bearing proximal to the curved portion and at least one bearing distal to the curved portion of the shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the device of Vaughn et al. with one bearing proximal to the curved portion and at least one bearing distal to the curved portion of the shaft. since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

With regard to claims 19-21, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the angled attachment tube of Vaughn et al. having an angle of between about 3° and about 30°; the tool having a height of about 1 to about 6 inches; the tool having a diameter of about 0.02 to about 0.5 inches to the axis of the base, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaughn et al. (US Pat. 5,569,256) in view of Mongeon et al. (US Pat. 4,728,876).

Vaughn et al. disclose the claimed invention except for the motor housing includes a tool chuck and said coupling assembly includes a work shaft, said work shaft removably coupled to said tool chuck. The tool chuck is moved to a locked position coupling the work shaft by rotational movement of said coupling assembly about a portion of said motor housing

Mongeon et al. disclose a tool chuck for use with an orthopedic drive assembly (column 4, lines 4-18). The tool chuck is used to engage various orthopedic surgical instruments (column 4, lines 4-18).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the device of Vaughn et al. with the tool chuck system as taught by Mongeon et al., in order to allow the device of Vaughn et al. to engage various orthopedic surgical instruments (column 4, lines 4-18).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571)

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272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



EDUARDO C. ROBERT  
SENIOR PATENT EXAMINER